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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
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09/297,532 06/28/99 FAJKOWSKI

F 8958.004

EXAMINER

MM91/0417

ROY KIESEL & TUCKER
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ST. CYR, D.	
ART UNIT	PAPER NUMBER

2876
DATE MAILED:

04/17/01

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trad marks

12

Office Action Summary

Application No.

09/297,532

Applicant(s)

FAJKOWSKI, PETER W.

Examiner

Daniel St.Cyr

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on 16 February 2001.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 25,42-47 and 49-53 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☐ Claim(s) 25, 42-47, 49-53 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claims _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are objected to by the Examiner.
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

- 15) ☒ Notice of References Cited (PTO-892)
- 16) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 17) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____.
- 18) ☐ Interview Summary (PTO-413) Paper No(s). _____.
- 19) ☐ Notice of Informal Patent Application (PTO-152)
- 20) ☐ Other: _____.

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DETAILED ACTION

1. Receipt is acknowledged of the amendment filed 2/16/01.

Claim Objections

2. Claims 25, 42-43, 46, and 53 are objected to because of the following informalities:

Appropriate correction is required.

Claim 25, line 1 "the radio" should be changed to --a radio--.

Claim 42, line 1 "the" should be changed to --a--.

Claim 43, line 2, delete "of the"; line 11 "may be " should be changed to -- is --.

Claim 46, line 1 "the" should be changed to --a--.

Claim 53, line 2, "another" should be changed to --a--; line 9, "another" should be changed to --the--.

Claim Rejections - 35 USC § 102

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

4. Claim 43-44 are rejected under 35 U.S.C. 102(e) as being anticipated by Aucsmith, US Patent No. 5,663,553.

Aucsmith discloses a mass storage device adapter for smart cards comprising: an adapter body sized to be inserted in a disk drive; an insertion port formed on said body for receiving said storage device; a reader head on said body for reading recorded data; a memory on said body for

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receiving contents of said recorded data; a wireless transmitter on said body for receiving electrical data and transmitting said electrical data in a wireless signal; and a processor for converting contents of said recorded data into electrical data which is transmitted through said wireless transmitter (see figures 3 and 5; col. 3, line 32 +).

Re claim 44, the reader is a magnetic reader head (see figure 3).

Claim Rejections - 35 USC § 103

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claims 45-46 and 50-53 are rejected under 35 U.S.C. 103(a) as being unpatentable over Johnsen, US Patent No 5,250,789, in view of Aucsmith. The teachings of Aucsmith have been disclosed above.

Johnsen discloses a shopping card which includes an adapter for converting recorded data from a disk drive device to electrical data for wireless transmission to a storage device, said adapter comprising an adapter body, said adapter body further comprising: a keyboard, a disk drive, a scanner and/or a serial port, any of which may be used for receiving data corresponding to a shopping list. The display system is in communication with a database to obtain the store location for each item in the shopping list. An organizing program is operable in the display system for organizing the shopping list in order of the store location for the items on the list. A display unit is provided so that the shopper may view the list of items for purchase in order of

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their store location. The display system may be mounted on a shopping cart for the convenience of the shopper. A product code scanner may be provided with the display system for inputting products as they are pulled from the shelves and added to the shopping cart. When the shopper has input either a list of coupons or scanned coupons in the shopper's possession into the display system, the system is able to notify the shopper when an item selected for purchase corresponds to one of the coupons (see figures 1-3; col. 6-8).

Johnsen fails to disclose or fairly suggest an adapter body sized to be inserted in a disk drive, but discloses that shoppers can use personal computers for compiling their shopping list on floppy disk, wherein their personal computers are connected to the store computer through a modem (see col. 5, lines 58-64; col. 8, lines 48-59).

In view of the disclosure of Aucsmith above, it would have been obvious to employ the device of Aucsmith into the system of Johnsen so that shoppers can securely personalizing their shopping list into smart cards before going to the market. Such modification would be ^{more} convenient and ^{more} reliable. Therefore, it would have been obvious.

7. Claims 25 and 42 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ruppert et al, US Patent No. 5,424,524.

Ruppert et al disclose a personal scanner/computer for displaying shopping lists and scanning barcodes to aid shoppers comprising: broadcasting a predetermined coupon data to a specific device, wherein the signal data is modified to be received by said specific storage device (see col. 5, line 48 to col. 6, line 18). Ruppert et al fail to disclose or fairly suggest radio broadcast for broadcasting the coupon data, but disclose an infrared transceiver for communicating the data. The infrared transceiver is an alternate and a functional equivalent

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communication means for communicating the data as disclosed by the applicant (see page 12 of the specification). Therefore, it would have been obvious.

8. Claims 47 and 49 are rejected under 35 U.S.C. 103(a) as being unpatentable over Johnsen as modified by Aucsmith. The teachings of Johnsen as modified by Aucsmith have been discussed above.

Re claim 47, Official notice is taken that it is common practice in the art, such as computer art, for providing LED for indicating when a disk is inserted in a disk drive. Therefore, it would have been an obvious expedient.

Re claim 49, Johnsen fails to disclose that the telephone subcomponent includes a speaker. However, since speakerphones are well known in the art for providing hands off communication, it would have been obvious to include a speakerphone in the system of Johnsen in order to be able to communicate to a customer while the customer is picking up items from the shelf.

Response to Arguments

7. Applicant's arguments filed 2/16/01 have been fully considered but they are not persuasive. (see the examiner remarks).

REMARKS:

In response to the applicant argument regarding claim 25, the examiner respectfully disagrees. Being functionally equivalent is to perform similar function. In this case both radio and infrared signals transmit information to customers. With regard to range of the signals, it is true that radio signals have a wider range of communication, but that would fall within the engineering design choice for meeting specific requirements. Furthermore, such limitation is not

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claimed. With respect to modifying the signal to be received by specific storage devices, the signal is modified so that it is compatible with every scanner within the system. Every scanner is designed and/or programmed to receive the specific signals generated. The applicant argument is not persuasive. Refer to the rejection above.

8. Applicant's arguments with respect to claims 43-47, 49-52 have been considered but are moot in view of the new ground(s) of rejection.

Conclusion

9. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Daniel St.Cyr whose telephone number is 703-305-2656. The examiner can normally be reached on Mon-Fri.

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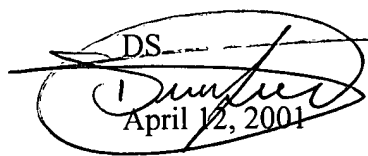
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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael G Lee can be reached on 703-305-3503. The fax phone numbers for the organization where this application or proceeding is assigned are 703-308-7722 for regular communications and 703-308-7724 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0956.

Daniel St.Cyr
Examiner
Art Unit 2876

DS

April 12, 2001


KARL D. FRECH
PRIMARY EXAMINER